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EXAMINER

HEINCER, LIAM J

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### ***Response to Arguments***

Applicant's arguments filed January 15, 2009 have been fully considered but they are not persuasive, because:

A) Applicants argument that Okada et al. teaches away from phosphonate compounds is not persuasive. Okada et al. teaches two specific examples using phosphonate linkages (Compounds 5a and 5b). When the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). See MPEP § 2131.02. Additionally, Okada et al. teaches compounds 5a and 5b as having excellent color tone, and comparable light transmittance and storage stability with the phosphate compounds tested (Table 12). As Okada et al. provides examples of phosphonates and describes the properties of these compounds as being substantially similar to phosphates, a person having ordinary skill in the art at the time of invention would have considered Okada et al. to be concerned with both phosphates and phosphonates.

B) Applicants argument that Okada et al. only teaches reacting phosphates with polyacrylic acid esters is not germane. Okada et al. teaches reacting "phosphoric acid or an active derivative thereof" with an alcohol containing methacrylic ester groups (11:44-49). As shown by the examples 2-carboxyethyl phosphonate is an active derivative of phosphoric acid that reacts with methacrylic esters of polyols (Examples 8-1 and 8-2). Therefore, a person having ordinary skill in the art at the time of invention would have a reasonable expectation of success when reacting the 2-carboxyethyl phosphonate of Okada et al. with the polyester compound of Billington et al.

C) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/

Supervisory Patent Examiner, Art Unit 1796

LJH

February 5, 2009